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09/935,483	08/23/2001	Ronald John Shimek	12929.1033USRE	9000

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EXAMINER

PRICE, CARL D

ART UNIT	PAPER NUMBER
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3749

DATE MAILED: 10/04/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/935,483

Applicant(s)

SHIMEK ET AL.

Examiner

CARL D. PRICE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31,32-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**Reissue Application**

**Request for Continued Examination: under 37 CFR 1.114**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02-19-2004 has been entered.

**Applicant's continuing obligation under 37 CFR 1.178(b)**

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,941,237 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

**Summary of Claims**

Original patented claims 1-14, 16 and 18 are unchanged.

Previously added claims 19-28, 30, 31, and 39 are unchanged.

Claims 15, 17, ~~29~~, 33, 35 and 36-38, and 40 are have been amended by applicant.

Claims 32 and 41-55 have been cancelled.

**Response to Arguments**

Applicant's arguments filed 02-19-2004 have been fully considered but they are not persuasive.

**Response to Applicants' Remarks: Prior Art Rejection**

With regard to applicant's arguments filed 02-19-2004, the examiner acknowledges applicants' current amendment to Reissue claims 20 and 29 which further defining the floor panel to be "substantially horizontal". Applicant argues Lamb discloses a "liner" for use in a fireplace, and that there is no suggestion that the liner disclosed by Lamb can function as a one piece combustion chamber. Applicants' attention is now directed to the prior art reference of Rex, Jr. et al (U.S. Patent No.- 3100734; of record) now being used to reject, for example, applicants' broadly stated invention of reissue claim 20 under 35 U.S.C. 102(b). Indeed, Rex, Jr. et al alone shows and discloses a molded self-supporting one piece fireplace combustion chamber having no particular wall structure (e.g. - panels), other than a "substantially horizontal" floor (figures 1-2) and made from a mixture of ceramic fibers and a binder. In use the chamber of Rex, Jr. et al includes a burner (not shown) a burner positioned relative to the floor

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panel, as well as the other panels of the chamber, to provide a flame within the combustion chamber. See the rejection of the claims herein below.

With regard to Lamb '783, the examiner can not agree with applicants' argument that the claim, now amended to include a "substantially horizontal" floor, defines applicants' claimed invention over the prior art. As discussed further herein below, the term "substantially horizontal" is a relative term which has been given no patentable weight. The examiner's position regarding Lamb '783 is therefore unchanged.

With regard to the prior rejection of claims 20-31 and 33-40, while applicant argues neither of Lamb '783 and Champion provide suitable teachings combinable under 35 U.S.C. 103 to reject the invention set forth in applicants' claims 20-31 and 33-40, applicant presents no discussion of the prior art reference of Shimek (U.S. Patent No.- 4792322) relied on in combination with the teachings of Lamb '783, or Champion, to reject the claims. In this regard applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

**Applicants' Remarks: Recapture**

Regarding the rejection of claims 20-31 and 33-40 under 35 U.S.C. 251, the examiner acknowledges the argument made by applicants that "according to the second part of the two step test used for recapture (recapture should not apply to limitations that have been completely

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removed, since the broader aspects do not relate to the surrendered subject matter” (pages 11-12). Applicants rely on *B. E. Meyers & Co. v. U. S.*, 47 Fed. Cl. 200 (Ct. Cl. 2000) (a copy of this decision being provided by applicants in the Appendix attached to the response) to support the conclusion that recapture should not apply to limitations that have been completely removed, since the broader aspects do not relate to the surrendered subject matter, is acknowledged by the examiner. The examiner also acknowledges the assertion made by applicants (page 12) that the “one-piece combustion chamber” of claim 20 is directed at an invention that is distinct from the “combustion chamber comprising a plurality of panels formed to provide a combustion chamber” defined by claim 8. In this regard, applicants’ attention is directed to the following discussion concerning the issue of improper recapture and the lack of replacement, or substitute, limitations in Reissue claims 20-31 and 33-40.

**Claim Comparison Table**

With regard to the following discussion regarding recapture, applicants should refer to the attached titled “Claim Comparison Table”, pages 19-20, which includes a side-by-side comparison of Reissue apparatus claims 19, 20 and 29 with patented apparatus claim no. 8 of U.S. Patent 5,941,237. As shown in the Claim Comparison Table claim 8 is written to include all amendments made thereto (i.e. – amendments to claim 12) during prosecution of original patent application S.N. - 08/538, 866.

**Prosecution History**

**(Patent Application S. N. - 08/538,866)**

In the office action mailed on 09-19-1997, paper no. 2, claims 1-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Scheppers in view of French '269.

In the response filed on 01-23-1998, paper no. 5; patent application S. N. - 08/538, 866 (U.S. Patent 5,941,237), applicants argue that apparatus claim 12 calls for "an open box of molded panels" and that the prior art reference of French '269 "can not be modified using the teachings of Scheppers and Rex Jr. to end up with a prefabricated fireplace having glass door means and burner means in a gas tight combustion chamber".

In this response applicants stated the following:

"Apparatus of Claim 12 calls for an open box of molded panels. While French '269 has an open chimney and hearth, the hearth cannot be modified using the teachings of Scheppers and Rex Jr. to end up with a prefabricated fireplace having glass door means and burner means in a gas tight combustion chamber."

In a manner consistent with the arguments presented by applicant in the response filed on 01-23-1998, applicants amended apparatus claim 12 to include, for example, the term "open box" (A1) to distinguish the "combustion chamber" over the prior art applied in the examiner's rejection of the claims. Applicants also, for example, changed "side wall panel means" to "two" (D3) side "panels" (D4), and "said side wall means" was changed to "said side panels" (F3). Each of key limitations A1, D3, D4, F3, L1, M, M1, N, P, P2, Q1 and R2 - V were added to apparatus claim 12, by applicants, in response to the rejection of claim 12 as being unpatentable

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over Scheppers in view of French '269. Claim 12, as amended by applicants, was then allowed as claim 8 in U.S. Patent 5,941,237. The file history therefore shows that the limitations D3, D4, F3, L1, M, M1, N, P, P2, Q1, and T which are now omitted in reissue claim 20, as well as limitations A1, L1, M, M1, N, P, P2, Q1, R2, S, T and V now omitted from reissue claim 29, are related to the subject matter previously surrendered by applicant in obtaining allowance of claim 8.

**Reissue Claims 19-31, 33-40: Certain Aspects Narrowed**

Reissue claims 19-31 and 33-40, added in the Reissue application, include limitations which narrow patent claim 8, with regard to certain elements.

Reissue claim 19, for example, include limitations H1 and I1 which narrow certain aspects of the invention, compared with applicants' patented apparatus claim 8 (U.S. Patent 5,941,237). There appears to be no indication in the prosecution history of S.N. – 08/588,866 that these limitations were originally presented, argued and stated to make application claim 12 (issued as patent claim 8) allowable over the prior art of record.

Reissue claim 20, for example, include limitations H1, K, O - O3, U, W and W1 which narrow certain aspects of the invention, compared with applicants' patented apparatus claim 8 (U.S. Patent 5,941,237). There appears to be no indication in the prosecution history of S.N. – 08/588,866 that these limitations were originally presented, argued and stated to make application claim 12 (issued as patent claim 8) allowable over the prior art of record.



And, Reissue claim 29, for example, include limitations C, D2, E, G-G5, H1 and I1 which narrow certain aspects of the invention, compared with applicants' patented apparatus claim 8 (U.S. Patent 5,941,237). There appears to be no indication in the prosecution history of S.N. – 08/588,866 that these limitations were originally presented, argued and stated to make application claim 12 (issued as patent claim 8) allowable over the prior art of record.

**Reissue Claims 19-31 and 33-40: Broadening scope**

Independent apparatus claims 19, 20 and 29, added in the reissue application, are broader in scope than applicants' apparatus patent claim 8 (i.e. - amended original application claim 12).

Reissue claim 19 broadens the scope of the patent claim 8. Claim 8 does not include limitation (I).

Reissue claim 20 broadens the scope of the invention by excluding whole aspects (D-F3, L-N1, P-Q1 and T) of patented claim 8. Broadened Reissue claim 20 raises the question of possible improper recapture of subject matter, or key limitations, previously surrendered by applicants, namely limitations D3-D4, F3, L1, M, M1, N, P, P2, Q1, T.

Reissue claim 29 broadens the scope of the invention by excluding whole aspects (A1 and L-V) of patented claim 8. Broadened Reissue claim 20 raises the question of possible improper recapture of subject matter, or key limitations, previously surrendered by applicants, namely limitations A1, L1, M, M1, N, P, P2, Q1, R2, S, T and V.

**No Replacement Limitation(s)**

Reissue claims 20 and 29 do not include limitations which replace key limitations now omitted in reissue claim 20 (i.e. - D3-D4, F3, L1, M, M1, N, P, P2, Q1, T), and those omitted in reissue claim 29 (i. e. - A1, L1, M, M1, N, P, P2, Q1, R2, S, T and V). For example, the “one piece fireplace combustion chamber” now set forth in applicants’ reissue claims 20 and 29 presents a broader description of one aspect of the invention which is not distinct from, the combustion chamber set forth in patent claim 8. Claim 8 of the patent was amended by applicants to include “**two** side **panels**” (D3, D4) in structural relationship with a floor and a top, also defined as “panels”. It is important to note that the broader “one piece fireplace combustion chamber”, now sought by applicant in the reissue claims, does not embody the cooperative relationship between a floor panel, a top panel and two side panels of patent claim 8: where “said floor panel, said top panel and said side **panels** (F3) **each** (F4)... formed and dried after **molding** (L1) provide a gas tight and impact resistant **box of** (M1) panels of a fireplace combustion chamber”. Again, it is noted that limitations D3, D4, F3, F4, L1 and M1 are key limitations related to amendments made by applicant in original application S.N. - 08/538, 866. The “one piece” chamber now sought by applicant, having been assigned no particular shape or form in the claims, need only include a “substantially horizontal floor” and be in the form of an otherwise non-descript open box. Therefore, with regard to the “chamber”, it is noted that Reissue claims 20-31 and 33-40 broaden the scope of the invention with regarding this aspect of the invention. However, in broadening the “chamber” aspect of the invention in the applicants’ have omitted key limitations D3, D4, F3 and L1. To overcome the art rejection applicants’ presented, argued

and stated limitations D3, D4, F3 and L1 and amended the chamber aspect of the original claim 12. These omitted key limitations are among elements which make up the chamber and are therefore necessarily interrelated with all aspects of the chamber. Applicants' Reissue claims fail to include substitute, or replacement, limitation(s) for these key limitations. By not presenting substitute, or replacement, limitations for these omitted key limitations applicants have presented claims which improperly recapture subject matter previously surrendered during the prosecution of the original application.

**Improper Recapture**

Concerning the question of recapture in Reissue application claims 20-31 and 33-40, as indicated herein above key limitations of patented claim 8 which are now omitted from the claims of the present reissue application were originally presented, argued and stated in the original application to define claim 12 over the prior art rejection of Schepper in view of French '269.

Claims 20-31 and 33-40 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue that was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject

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matter that applicant previously surrendered during the prosecution of the application.

Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

As discussed herein above, the key limitations omitted from claims 20-31 and 33-40 of the present reissue application are:

Reissue Claim	See Claim Comparison Table
20	D3-D4, F3, L1, M, M1, N, P, P2, Q1, T
29	A1, L1, M, M1, N, P, P2, Q1, R2, S, T, V

**Duplicate Claims**

Applicant is advised that should claims 22,23,24 and/or 25 be found allowable, claims 31,33,34,35 and/or 36 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

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**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The term "horizontal" in claim 20-31 and 33-40 is a relative term which renders the claim indefinite. The term "horizontal" is not defined by the claim and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 37-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 37-40, there is no proper antecedent basis for the term "the bottom portion".

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 20, 29, 30, 37, 40: Rejected under 35 U.S.C. 102(b)**

Claims 20, 29, 30, 37 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Rex, Jr. et al (of record).

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Rex, Jr. et al shows and discloses a molded self-supporting one piece fireplace combustion chamber, having no particular wall structure (e.g. – panels) in the same manner broadly set forth in applicants' claims. The ceramic material used in Rex, Jr. et al is a moldable mixture of refractory fibers (e.g. - aluminum silicate fiber material) which, after being molded in a mixture of inorganic refractory colloidal binder into the form of a combustion chamber enclosure, is removed from the mold and dried to form a self-supporting unit. The lower

Rex, jr. et al shows (figures 1-2) and discloses, see column 1, lines 3-6:

“The invention relates to a furnace combustion chamber and more particularly to a chamber adaptable for oil-fired furnace units. This product employs *refractory fibers molded into required shapes* and reinforced by organic and *inorganic binders* varied in proportions determined by temperature and strength requirements”.

Rex, jr. et al discloses, at column 2, lines 29-41:

“In order to form a uniform and homogeneous structure, it is important to disperse the fibers uniformly in the solution. A foraminous *mold* having an exterior surface conforming with the interior configuration of the furnace chamber is submerged into the solution which is *drawn by vacuum through the mold* causing the fibers to be deposited upon the mold surface. ... The mold is then withdrawn from the solution and by means of vacuum, the furnace chamber is *removed from the mold and thoroughly dried*, whereupon it becomes a *self-supporting unit*.”

Rex, Jr. et al claims :

1. A combination chamber, said chamber comprising a *fibrous refractory material*, said material being *formed into an enclosure*, ... , said enclosure *having a burner opening*, said enclosure having a *burned gas outlet*, said fibrous material as formed into said enclosure being held in *a stable self supporting structural furnace combustion chamber form by an inorganic refractory colloidal binder*.
2. A combustion chamber as set forth in claim 1 wherein the refractory fibrous material comprises *aluminum silicate fiber*.

**Claims 20, 21, 29, 30, 37 and 40 are rejected under 35 U.S.C. 102(b)**

Claims 20, 21, 29, 30, 37 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Lamb et al (GB 2 257 783).

Lamb et al '783 show and disclose an a one-piece rigid, or stiff, open box combustion chamber (figure 2) having sidewalls (20) and a bottom (19) rear wall (18) and top wall (30), combustion chamber The combustion chamber of Lamb et al being made by the method of 1) molding an aqueous slurry of ceramic fiber (see page 1, line 20 - page 2, line 3) and an inorganic binder (i.e. – silica; see page 2, line 6), 2) removing the molded chamber from the mold followed by 3) drying “with or without heat” (see page 2, line 4). A burner (not shown; see page 3, line 14) is positioned on a bottom wall (16) and relative to the floor panel (19) to provide a flame within the chamber. A front panel (12) coupled to the firebox.

In regard to claims 20-31 and 33-40, the recitation “for use in a plurality of different types of fireplaces” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In addition, since the term "horizontal", in claim 20-31 and 33-40, is a relative term which is not otherwise defined by the claim, and since the term “horizontal” relates to a spatial

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orientation, rather than the manner in which the claimed element relates to other elements recited in the claim, no patentable weight can be given thereto.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20 –31 and 33- 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimek et al (U.S. Patent No. 4,793,322) in view of Lamb et al (UK 2 257 783), Rex, Jr. et al (U.S. Patent No. 3,100,734) or Champion.

Shimek et al show and disclose a refractory panel open box combustion chamber (figure 2) having sidewalls (24,25) and a refractory material bottom panel (80) and rear wall (26). A burner (62) is positioned on and through an opening in the refractory material bottom panel and relative thereto to provide a flame within the chamber. A front panel (at 81) coupled to the firebox. The bottom portion (45, 48, 75) provides fluid communication of combustible gas to the aperture.



Lamb et al show and disclose a one-piece rigid, or stiff, open box combustion chamber (figure 2) having sidewalls (20) and a bottom (19) rear wall (18) and top wall (30). The combustion chamber of Lamb et al being made by the method of 1) molding an aqueous slurry of ceramic fiber (see page 1, line 20 - page 2, line 3) and an inorganic binder (i.e. – silica; see page 2, line 6), 2) removing the molded chamber from the mold followed by 3) drying “with or without heat” (see page 2, line 4). A burner (not shown; see page 3, line 14) is positioned on a bottom wall (16) and relative to the floor panel (19) to provide a flame within the chamber. A front panel (12) coupled to the firebox.

Champion shows (figure 1) a one-piece open box refractory material combustion chamber (15) having sidewalls (33, 34) and a bottom (30) rear wall (31) and top wall (32). The bottom wall of the combustion chamber of Champion supports a wood log type burner

Rex, Jr. et al show and disclose a combustion chamber (figure 1) having sidewalls and a bottom (not referenced). The “self supporting”, rigid or stiff, combustion chamber (see column 2, lines 40-41) of Rex, Jr. et al being made by the method of 1) vacuum molding ceramic fiber, mixed with an aqueous solution water and an “inorganic” binder (see column 2, lines 7-8; “These fibers are placed in a tank of water with colloidal silica), 2) removing the molded chamber from the mold followed by 3) thorough drying. The combustion chamber is then heated in the furnace after installation to temperatures “up to 2300” degrees F.

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In regard to claims 20 – 31 and 33-40, for the purpose of providing a suitable refractory, (e. g. – high temperature heat resistant material) for the combustion chamber, and to simplify assembly of the Shimek et al fireplace, it would have been obvious to a person having ordinary skill in the art to form the combustion chamber of Shimek et al as a one-piece molded member having top, rear, side and bottom walls of the same refractory material, in view of the teachings of Lamb et al, Champion and Rex, Jr. et al. Also, for the purpose of providing a suitable refractory material for the Shimek et al combustion chamber, it would have been obvious to a person having ordinary skill in the art to make the one-piece chamber by the method of 1) molding an aqueous slurry of ceramic fiber and an inorganic binder removing the molded chamber from the mold followed by drying in view of the teachings of Lamb et al or Rex, Jr. et al. In regard to claims 22, 23, 34 and 35, Official Notice is taken that it is well known to use open pan burners as a flame source in simulated log type gas fireplaces. Thus, in view of that which is well known, it would have been obvious to a person having ordinary skill in the art to modify the burner of Shimek et al to be in the form of an open pan type burner.

**Reissue Oath/Declaration**

**Offer to Surrender**

Applicant's offer to surrender the original patent is acknowledged. The original patent, or statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed.

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**Claims 1-31,33-40 are rejected as being based upon a defective reissue declaration**

Claims 1-31 and 33-40 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175.

The nature of the defect is as follows:

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

“Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant.”

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(Claim Comparison Table)

	U.S. Patent No. 5,647,340	Reissue Claim - Claim 19	Reissue Claim - Claim 20	Reissue Claim - Claim 29
A	8. A universal	19. A universal	20. An <del>universal</del>	29. A <del>universal</del>
A1	<u>open box</u>	open box	open box	<del>open box</del>
B	combustion chamber	combustion chamber	combustion chamber	combustion chamber
B1	for use in a plurality of	for use in a plurality of	for use in a plurality of	for use in a plurality of
B2	different types	different types	different types	different types
B3	of fireplaces comprising,	of fireplaces comprising:	of fireplaces, comprising <del>the</del> ;	of fireplaces, comprising <del>the</del> ;
B4			a one piece fireplace	
B5			combustion chamber	
C				a <u>substantially horizontal</u>
D	a floor panel,	a floor panel,	→ <del>a floor panel</del>	floor panel;
D1	a top panel,	a top panel,	<del>a top panel</del>	a top panel;
D2				<u>at least</u>
D3	<u>two side</u> [wall panel means]	two side	<del>two side</del>	<u>two side</u>
D4	<u>panels</u> ,	panels,	<del>panels</del>	<u>panels</u> ;
E				<u>wherein</u>
F	said floor panel,	said floor panel,	<del>said floor panel</del>	<del>said</del> the floor panel,
F1	said top panel and	said top panel and	<del>said top panel and</del>	<del>said</del> the top panel and
F2	said side [wall]	said side	<del>said side</del>	<del>said</del> the side
F3	<u>panels</u> [means]	panels	<del>panels</del> } ←	<u>panels</u>
F4	each comprising	each comprising	<del>each</del> comprising	<del>each comprising</del>
G				<u>are molded to form a one</u>
G1				<u>piece fireplace combustion</u>
G2				<u>chamber;</u>
G3				<u>wherein the one piece</u>
G4				<u>fireplace combustion chamber</u>
G5				<u>is molded of</u>
H	a mixture of	a mixture of	a mixture of	a mixture of
H1		<u>refractory</u>	<u>refractory</u>	<u>refractory</u>
I	vitreous alumina silicate	<del>vitreous alumina silicate</del>	<del>vitreous alumina silicate</del>	<del>vitreous alumina silicate</del>
I1		<u>ceramic</u>	<u>ceramic</u>	<u>ceramic</u>
	fibers	fibers	fibers	fibers
	and	and	and	and
J	an aqueous solution of	an aqueous solution of	<del>an aqueous solution of</del>	<del>an aqueous solution of</del>
J1	[silicate]			
K	binder	binder	a binder,	a binder.

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	(Continued)	(Continued)	(Continued)	(Continued)
	Patent Claim 8 (Continued)	Reissue Claim - Claim 19 (Continued)	Reissue Claim - Claim 20 (Continued)	Reissue Claim - Claim 29 (Continued)
L L1	formed and dried after <u>molding</u> [mixing]	formed and dried after molding	→ <del>[formed and dried after molding]</del>	→ <del>[formed and dried after molding]</del>
M M1	to provide a gas tight and impact resistant <u>box of</u> panels of	to provide a gas tight and impact resistant box of panels of	<del>to provide a gas tight and impact resistant box of panels of</del>	<del>to provide a gas tight and impact resistant box of panels of</del>
N N1	a <u>fireplace</u> combustion chamber, [and]	a fireplace combustion chamber;	<del>a fireplace combustion chamber.] ←</del>	<del>a fireplace combustion chamber.</del>
O O1 O2 O3			wherein the one piece <u>fireplace combustion chamber</u> comprises a substantially horizontal floor panel;	
P P1 P2	<u>glass door</u> means [for connecting] <u>attached to</u>	glass door means attached to	→ <del>[glass door means attached to said panels]</del>	<del>glass door means attached to said panels]</del>
P3	said panels [with each other at their mating joints]	said panels		
Q Q1	to provide a gas tight <u>closed box fireplace</u>	to provide a gas tight closed box fireplace;	<del>to provide a gas tight closed box fireplace]</del>	<del>to provide a gas tight closed box fireplace</del>
R R1	[high temperature combustion chamber], <u>and</u>	and	and	<del>and</del>
R2	<u>burner</u>	burner	a burner	<del>burner</del>
S T	<u>means supported by said floor panel.</u>	means supported by	→ <del>[ means supported by ] ←</del> positioned relative to	<del>means supported by said floor panel.] ←</del>
U V W W1		<del>[said]</del> <u>the</u> floor panel.	<del>[said]</del> <u>the</u> floor panel to provide a flame within the combustion chamber.	

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Conclusion

USPTO CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL D. PRICE whose telephone number is 703-308-1953. The examiner can normally be reached on Monday through Friday between 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on 703-308-1935. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Cp